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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,692	01/28/2004	Barry S. Bjugstad	3218.01US02	2073
24113 7590 12/19/2006 PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			EXAMINER HWANG, VICTOR KENNY	
			ART UNIT	PAPER NUMBER
			3764	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>10/766,692</p>	<p>Applicant(s)</p> <p>BJUGSTAD ET AL.</p>	
	<p>Examiner</p> <p>Victor K. Hwang</p>	<p>Art Unit</p> <p>3764</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>April 7, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "122" identifying the generally rectangular cross-section on page 5, line 20. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "154" has been used to designate both the boot portion and the front extension. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by *Nolan* (US Pat. App. Pub. No. 2003/0130070 A1). *Nolan* discloses a training apparatus comprising a weighted tape portion 40 having a malleable core member 30 enclosed within a protective cover 70, the weighted tape portion having a substantially flat configuration wherein a tape width dimension is shown as being at least two times greater than a tape thickness dimension (see paragraph [0029], lines 1-6). The core member is reusably conformable about an external surface of a hockey device. A first securement strap 20 is fixedly attached to the weighted tape portion and can be used for fixedly securing the weighted tape portion with respect to the hockey device. The malleable internal core member is comprised of lead. The protective coating comprises a polymeric material, such as plastic. The hockey device could be a hockey stick or an ice skate.

The weighted wrapping means is hand malleable such that it is conformable to an exterior geometry of an athletic device (see paragraph [0034], lines 4-9). The securing means attached to the weighted wrapping means retains the weighted wrapping means to the athletic device when the weighted wrapping means has been conformed to the athletic device. The application of the weighted tape to a hockey stick or ice skate is an intended use of the apparatus and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. Claims 1-4, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by *Gruget* (US Pat. 3,342,036). *Gruget* discloses a training device comprising a weighted tape 10 having a malleable core member 17 enclosed within a protective cover 14,15. The weighted tape portion has a substantially flat configuration wherein a tape width dimension is shown as being at least two times greater than a tape thickness dimension. The core member can be reuseably conformable about an external surface of a hockey device. A first securement strap 13 is fixedly attached to the weighted tape portion and can be used for fixedly securing the weighted tape portion with respect to a hockey stick. The malleable internal core member is comprised of lead and the protective cover comprises a polymeric coating, such as plastic. A securing buckle 12 receives the first securement strap to promote securement of the tape portion. The hockey device could be a hockey stick or an ice skate.

The application of the weighted tape to a hockey stick or ice skate is an intended use of the apparatus and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zajac et al.* (US Pat. 6,939,273 B2) in view of *Nolan* (US Pat. App. Pub. No. 2003/0130070 A1). *Nolan* has been discussed above, and such discussion is incorporated herein. *Zajac et al.* discloses a hockey training device comprising a weighted tape portion 32,34,36 or 38 having a metal core member enclosed within a protective covering. The weighted tape portion has a substantially flat configuration wherein a tape width dimension is shown as being at least two times greater than a tape thickness dimension. First and second securement straps 62 and 64 are individually adapted to secure the tape portion to the hockey device. The securement straps comprise hook and loop material releasable fasteners.

The hockey device is a hockey stick 66. The weighted training tape is placed in proximity to the hockey stick 66, the tape is conformed to an exterior geometry of the hockey

stick, the training tape is secured to the hockey stick using the first securement strap 62 fastened to the training tape. The second securement strap 64 is also used to secure the training tape to the hockey stick. The training tape can be removed from the hockey stick to change the weight of the training tape by releasing the first securement strap to reform the training tape to a substantially open position.

Zajac et al. does not disclose that the core member is malleable (claims 1, 7 and 11); the malleable internal core member is comprised of lead (claim 2); and the protective coating comprises a polymeric coating (claim 3).

Nolan discloses a weight training tape analogous to the weight training tape disclosed by *Zajac et al.* The weight training tape is used for baseball bats, but the prior art teaches that training weights can be applied to hockey sticks also (paragraphs [0004] and [0005]. The core member 30 of *Nolan* is malleable or manually reshapeable (paragraph [0027]) and comprises lead covered with a non-toxic plastic coating and being approximately 1/8 inch thick. The reshapeable weights assists in retaining the weights on the athletic device and provides a continuous feel to the athletic device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the core member of *Zajac et al.* be a coated, malleable lead core member, since *Nolan* discloses that malleable weights assist in retaining the training tape in position on the athletic device and makes the training tape feel more like a continuous part of the athletic device.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rucks (US Pat. 3,582,067), *Bouchard* (US Pat. 3,608,907), *Gemmel et al.* (US Pat. 3,870,328), *Ouellette* (US Pat. 3,901,524), *Dohner* (US Pat. 5,162,032) and *Beausoleil* (US Pat. 7,063,650 B1) disclose weighted apparatus explicitly shown for use with hockey devices.


Kimura (US Pat. 4,369,967) discloses a weighted apparatus comprising a malleable lead core member with a polymeric coating.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.


The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor K. Hwang
December 11, 2006



(JACKIE) TAN-UYEN HO
PRIMARY EXAMINER
12/11/06